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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,982	11/19/2001	Jennifer L. Hillman	PF-0269-3 DIV	9688

7590

05/08/2002

Legal Department
Incyte Genomics, Inc.
3160 Porter Drive
Palo Alto, CA 94304

EXAMINER

RILEY, JEZIA

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,982

Applicant(s)

HILLMAN ET AL.

Examiner

Jezia Riley

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FILE

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-18, 28 and 29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.*
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Action*.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2, drawn to a polypeptide, classified in class 530, subclass 350.
- II. Claims 3-6, 12, 13, drawn to a polynucleotide, classified in class 536, subclass 22.1.
- III. Claim 7, drawn to a host cell, classified in Class 435, subclass 252.3;
- IV. Claim 8, drawn to transgenic organism, classified in class 435, subclass 410; Class 424, subclass 132.1.
- V. Claims 9 and 10, drawn to a method of producing a polypeptide, classified in class 435, subclass 69.1.
- VI. Claim 11, drawn to an antibody, classified in class 530, subclass 387.1.
- VII. Claims 14-16, drawn to a method of detection, classified in class 435, subclass 6.
- VIII. Claims 17 and 18, drawn to a pharmaceutical composition, classified in Class 514, subclass 1.
- IX. Claim 28, drawn to a method for screening a compound, classified in class 435, subclass 6.
- X. Claim 29, drawn to a method for assessing toxicity, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

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The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I, II, VI, VIII are independent inventions because they are directed to different chemical types regarding the critical limitations therein. For Group I the critical feature is a polypeptide; for Groups II the critical feature is nucleic acids; and for Group VI the critical feature is an antibody. It is acknowledged that various processing steps may cause a polypeptide to be directed as to its synthesis by a polynucleotide, however, the completely separate chemical types of the inventions of the nucleic acid, polypeptide, and antibody Groups supports the undue search burden if both were examined together. Additionally, polynucleotides, polypeptides, and antibodies have been most commonly, albeit not always, separately characterized and published in the Biochemical literature, thus significantly adding to the search burden if examined together as compared to being searched separately. Also, it is pointed out that processing that may connect two Groups does not prevent them from being viewed as distinct because enough processing can result in producing any composition from any other composition if the processing is not limited as to additions, subtractions, enzyme action, etc. Thus, the three Groupings are independent and/or distinct invention types for restriction purposes.

The inventions of Group I-X are related as product and distinct processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the nucleic acids of Group II can be used in the distinct processes of the inventions of Groups II, VII, IX or X, etc. One use is directed to polypeptide expression and another to screening via nucleic acid binding reactions. The polypeptides of Group I can be used in the distinct inventions of Groups VIII, etc., or, alternatively, the activity of a protein can be utilized in an industrial process for chemical processing.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

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or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jezia Riley whose telephone number is 703-305-6855. The examiner can normally be reached on 9:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

May 6, 2002


JEZIA RILEY
PRIMARY EXAMINER